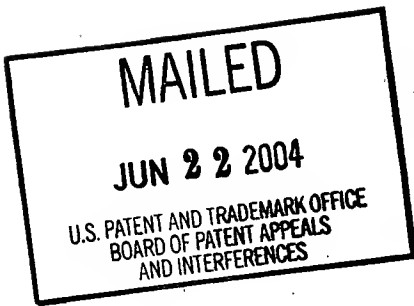


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte SANJIV G. TEWANI, MARK W. LONG
MARK O. BODIE and JAMES P. HAMBERG

Appeal No. 2004-1266
Application No. 09/997, 745

ON BRIEF

Before WALTZ, DELMENDO and JEFFREY T. SMITH, *Administrative Patent Judges*.
JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1 to 14, all of the pending claims. We have jurisdiction under 35 U.S.C. § 134.¹

¹ In rendering this decision, we have considered Appellants' arguments presented in the Brief filed April 01, 2003 and the Reply Brief filed July 14, 2003.

BACKGROUND

Appellants' invention relates to powertrain mounts for motor vehicles. The claimed invention includes a floating orifice track. (Brief, p. 2). Claims 1, 5 and 9, which are representative of the claimed invention, appear below:

1. A powertrain mount comprising:
an orifice plate defining an orifice track having a first cross-sectional area; and
a slug slidably disposed in the orifice track, the slug having a bore with a second cross-sectional area less than the first cross-sectional area.

5. A powertrain mount comprising:
a base plate;
a molded member connected to the base plate;
an orifice plate connected to one of the base plate or the molded member, the orifice plate defining an orifice track having a first cross-sectional area; and
a slug slidably disposed in the orifice track, the slug having a bore with a second cross-sectional area less than the first cross-sectional area.

9. A mount for a powertrain component of a motor vehicle, the mount comprising:
a base plate;
a molded member connected to the base plate;
an orifice plate connected to one of the base plate or the molded member, the orifice plate defining an orifice track having a first cross-sectional area; and
a slug slidably disposed in the orifice track, the slug having a bore with a second cross-sectional area less than the first cross-sectional area.

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As evidence of unpatentability, the Examiner relied on the following prior art:

Lee et al. (Lee)

6,056,279

May 02, 2000

THE REJECTION

The Examiner entered the following rejections:

The Examiner rejected claims 1 to 13 under 35 U.S.C. § 102(b) as anticipated by Lee; and claim 14 under 35 U.S.C. § 103(a) as obvious over Lee.

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1, 5 and 9.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants concerning the above-noted rejections, we refer to the Answer, Brief and Reply Brief for the full exposition thereof.

OPINION

The review of the grounds of rejection of the appealed claims necessarily entails the interpretation of the scope of the appealed claims. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In the present case, independent claims 1, 5 and 9 all include the element "orifice track". The specification describes the orifice track as follows:

The orifice track has a relatively small, restricted flow passage extending around the perimeter of the orifice plate. Each end of the track has an opening, with one opening communicating with the primary chamber and the other with the secondary chamber. The orifice track provides the hydraulic mount assembly with another passive tuning component.

[Specification, page 2]

The Examiner in rejecting the subject matter of claims 1, 5 and 9 did not properly consider the powertrain mount containing an orifice track as described in the claims. The Examiner has not identified a portion of the Lee reference which specifies an orifice track that has a flow passage that extends around the perimeter of the orifice plate.²

Lee describes a hydraulic pumping mount that comprises a partition wall (23) that separates the cavity (30) into a pair of working chambers. (Col. 3, ll. 11-12). Lee also discloses that the partition wall (23) has an opening (36) that engages the tube (34) that extends through the working chambers. (Col. 3, ll. 15-17). However, the Examiner in the Answer, page 3, states "Lee et al. discloses a mount comprising an orifice plate (23) defining an orifice track (interpreted by the examiner as the orifice through which slug 34 extends) having a first cross-sectional area and a slug (34) slidably disposed in the orifice track, the slug having a bore with a second cross-sectional area less than the first cross sectional area. (Figures 1 and 2)". The element identified by the Examiner as the "orifice through which

² In order for a claimed invention to be anticipated under 35 U.S.C. § 102, all of the elements of the claim must be found in one reference. *See Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

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slug 34 extends” does not define an orifice track that has a flow passage that extends around the perimeter of the orifice plate as required by the claimed invention, as properly interpreted. The identified element is an opening in the partition wall and does not extend around the perimeter of the partition wall.

Thus, we reverse the rejection of claims 1 to 13 under 35 U.S.C. § 102(b) as anticipated by Lee; and claim 14 under 35 U.S.C. § 103(a) as obvious over Lee.


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CONCLUSION

For the foregoing reasons we reverse all of the rejections presented in this appeal.

REVERSED

Thomas A. Waltz
THOMAS A. WALTZ
Administrative Patent Judge

 BO
ROMULO H. DELMENDO
Administrative Patent Judge

**BOARD OF PATENT
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JEFFREY T. SMITH
Administrative Patent Judge

JTS/gjh

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DELPHI TECHNOLOGIES, INC.
Legal Staff Mail Code: 482-204-450
1450 W. Long Lake
P.O. Box 5052
Troy, MI 48098